

19. The ink jet receiving layer of claim 12 wherein the metal salt comprises barium chloride.

### **REMARKS CONCERNING THE AMENDMENTS**

The above amendments were made in an effort to more clearly define the present invention and to respond to issues raised in the Office Action. Antecedent basis for the amendments may be found in the original specification in general and, for example:

- 1) For the amendment to claim 9, see Example 1 where ink receiving layers are coated adjacent to one another.
- 2) For the new claims 10-15, antecedent basis may be found generally in the specification, in original claims 1-9 (where the metals were listed) and in the examples, where nitrate and sulfate and chloride were specifically used.

### **RESPONSE TO THE REJECTIONS**

#### **Claim 9 Has Been Rejected Under 35 U.S.C. 112, Second Paragraph**

This rejection has been overcome by the Amendment to claim 6. This issue is now moot.

#### **Claims 1, 2, 4 and 7 Have Been Rejected Under 35 U.S.C. 103(a) as Obvious over Any One of Eight References: Jones (US 4,649,064); Akutsu (US 4,740,420); Aono (U.S. 4,946,781); Kondo (US 5,320,897); Akutsu (GB 2 147 003); Body (GB 2 301 845) and Fryberg (EP 0 705 172 B1)**

Each of these rejections has been set forth identically, the Office Action asserting that each reference shows an ink-jet receiving layer comprising gelatin and a metal salt of a Group IIA or IIB metal. The rejection asserts that it would be an obvious matter of choice to ascertain optimum operating conditions, specifically determining that a pH range for the surface sheet provides improved properties.

This rejection is in error for a number of reasons. The first and most important reason is that there must always be a specific target of optimization for one of ordinary skill

in the art to consider before attempting to optimize the product. It is not obvious to consider each and every property in a material or layer, unless that specific property previously has been suggested as meaningful towards performance, and towards a specific property of performance by one of ordinary skill in the art. There are so many varied properties that one could consider (such as molecular weight of binders, density of the layer, electrical conductivity of the layer, oxygen permeability of the layer, electrical resistance, flexibility, elasticity, acid value, base value, crosslink density, dispersivity, solubility, etc., etc.) that it is not even obvious to examine each and every one of these properties to determine if they have an effect on the actual performance of the material in a specific environment, such as in an ink-jet receiver layer. Even if one were motivated to search each of the properties and their effects, to be obvious, one must have an expectation that changing a property will have a specific type and degree of functional effect on the performance of the layer. For example, if one were to evaluate the effect of changing the oxygen permeability of an ink-jet receiving layer, there would not be an expectation that variations in such a property could impact the stability of colors in printed images. Without an expectation of the type and degree of effect that a variation in a property (even if attempting to optimize the product by its relationship to that property), it cannot be obvious to vary that property, especially where (as in the present case) that variation effects a significant beneficial effect on the properties of the layer that were not predictable prior to the work of Applicants.

The Examiner has acknowledged that the data in the specification “establishes that unexpected results are obtained with their pH parameter when calcium nitrate is employed with gelatin...), however, the Examiner apparently did not appreciate the broader teaching **and evidence** of unexpected results with other metals (within the IIA and IIB group) and with other anions. See Examples 8, 9 and 10, for example. The evidence of unexpected results is therefore much broader than first appreciated and is commensurate in scope with claim 1. It is therefore clear that Applicants have established unobviousness over the prior art for claims commensurate in scope with claim 1. Applicants have also provided claims of intermediate scope that are patentable under the same guidelines.

There is no basis for asserting that the use of the specific pH in combination with gelatin **and** metal salts of Group IIA and IIB metals could be used as a coating on a substrate to provide an ink jet receiving layer that beneficially modifies the performance properties of the image. That is an unexpected property and an unexpected result that has been substantiated by comparative examples. The scope of claims is commensurate with the evidence presented.

This rejection is therefore in error and must be withdrawn.

### CONCLUSION

All rejections have been shown to be in error. The references fail to teach the invention as claimed and do not indicate the unexpected properties that have been shown in the examples in the specification. The claims have been shown to be patentable over the art used in the rejections and all claims should be allowed.

The Examiner is invited to telephone Applicants' below-listed representative at (952)832.9090 to facilitate prosecution of this application.

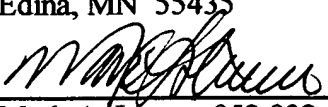
Respectfully submitted,

Alain Dominique Sismondi et al.

By their Representatives,

MARK A LITMAN & ASSOCIATES, P.A.  
York Business Center, Suite 205  
3209 West 76<sup>th</sup> Street  
Edina, MN 55435

By

  
Mark A. Litman 952.832.9090  
Registration No. 26,390

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to BOX Amendment, Assistant Commissioner of Patents, Washington, D.C. 20231 on September 3, 2002.

Name Mark A. Litman

  
Signature